

DOCKET NO.: ZMOG-0119

PATENT

5/4/10
#16

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Scott R. Presnell et al.

Confirmation No.: 9291

Application No.: 09/397,846

Group Art Unit: 1647

Filing Date: September 27, 1999

Examiner: David S. Romeo

For: MAMMALIAN TRANSFORMING GROWTH FACTOR BETA - 9

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT
BASED ON EVIDENCE THAT A REPLY WAS TIMELY MAILED OR FILED**

Pursuant to MPEP 711.03(c)(I)(B), Applicant hereby petitions to withdraw the holding of abandonment on the basis that a petition for extension of time was timely and properly submitted, but was mishandled upon receipt at the USPTO.

On December 16, 2003, the petition for an extension of time was sent by Express Mail in a package that also contained filing documents for a continuation application. A copy of the petition for an extension of time is attached as Exhibit A. A list of the contents of the Express Mail package, indicating, as item 8, a Petition and Fee for Extension of Time for USSN 09/397,846 (in duplicate) is attached as Exhibit B. In compliance with MPEP 201.06(c)(X), the petition for an extension of time was filed as a separate paper, and was clearly directed to the present application.

Evidence that the USPTO timely received the Express Mail package, including the petition for an extension of time, is found in the file history for US Application Serial No. 10/738,929, the continuation application filed along with the petition on December 16, 2003. The item labeled "Transmittal of New Application" is stamped as received on December 16, 2003, and includes at page 5 the Petition and Fee for Extension of Time directed to the present application.

The USPTO apparently failed to direct the petition to the proper application. Accordingly, the present application was abandoned as of September 17, 2003, creating a break in the copendency necessary to perfect the priority claim of the continuing application.

As set out in MPEP 206.06(c)(XI), the prior nonprovisional application is not automatically abandoned upon filing of a continuing application. Applicants therefore were not concerned when they received the Notice of Abandonment for failure to reply in the present application

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(attached as Exhibit ~~C~~). Additionally, because the Notice of Abandonment provided no indication of the date of abandonment, Applicants remained unaware of the break in copendency.

In an Office Action mailed May 28, 2009, in US Application Serial No. 11/557,689, which claims priority through the present application, the Examiner pointed out the lack of copendency (see the Office Action attached as Exhibit D).

In their reply of October 28, 2009, Applicants traversed the rejection of priority, pointing out that the petition for extension of time had been properly and timely filed (see Remarks attached as Exhibit E).

The Examiner maintained his rejection of priority based on lack of copendency in the Final Rejection mailed January 5, 2010. Upon consideration of this Final Rejection, Applicants reviewed the Patent Application Information Retrieval system records and discovered that the properly filed petition had never been considered, and in fact, had been placed in the record of the wrong application. Applicants recently further identified that the petition fee was not collected from Applicants' deposit account.

Based on the USPTO's failure to consider the properly and timely filed petition for an extension of time, Applicants respectfully request that the USPTO withdraw the holding of abandonment on September 17, 2003, and change the date of abandonment to December 17, 2003, to properly reflect the requested extension of time.

The Commissioner is hereby authorized to charge any deficiency in the fees associated with this communication to Deposit Account No. 23-3050.

Date: May 4, 2010

/Deborah A. Sawislak/

Deborah A. Sawislak
Registration No. 37,438

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Facsimile: (215) 568-3439

Exhibit A

PATENT APPLICATION
File No: 98-54

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Scott R. Presnell, David W. Taft, Kevin P. Foley
Serial No. : 09/397,846
Group Art Unit : 1647
Examiner : Romeo, D.
Filed : September 17, 1999
For : MAMMALIAN TRANSFORMING GROWTH FACTOR BETA -
9
Date Submitted : December 16, 2003

PETITION AND FEE FOR EXTENSION OF TIME (37 C.F.R. 1.136(a))

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

It is respectfully requested that the time for response to the Office Action dated June 16, 2003 be extended for a period of three months from September 16, 2003 to December 16, 2003.

Applicants claim small entity status. Please charge the total fee, estimated to be \$475.00, to ZymoGenetics, Inc., Deposit Account No. 26-0290. A duplicate of this sheet is enclosed.

Respectfully submitted,

Michelle L. Johnson

Michelle L. Johnson
Registration No. 36,352

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

EXPRESS MAIL CERTIFICATE

Mail Stop Patent Application
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: U.S. Patent Application for
MAMMALIAN TRANSFORMING GROWTH FACTOR BETA-9

Applicants: Scott R. Presnell, David W. Taft, Kevin P. Foley

Sir:

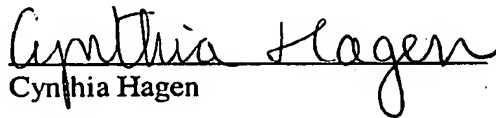
Express Mail Label No. EL988277229US

Date of Deposit December 16, 2003

I hereby certify that the following attached paper(s) or fee

1. Return Postcard
2. Application And Fee Transmittal (in duplicate)
3. Patent Application (82 pages)
4. Copy of Executed Declaration and Power of Attorney
5. Sequence Listing (16 pages)
6. Letter Regarding Sequence Listing
7. Letter Identifying Changes
8. Petition and Fee for Extension of Time for USSN 09/397,846 (in duplicate)

are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" under 37 C.F.R. 1.10 on the date indicated above, addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


Cynthia Hagen

ZymoGenetics, Inc.
1201 Eastlake Avenue East
Seattle, WA 98102
(206) 442-6600



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,846	09/17/1999	SCOTT R. PRESNELL	98-54	9291

7590

03/23/2004

Michelle
PAUL G LUNN ESQ
ZYMOGENETICS INC
1201 EASTLAKE AVENUE EAST
SEATTLE, WA 98102

EXAMINER

ROMEO, DAVID S

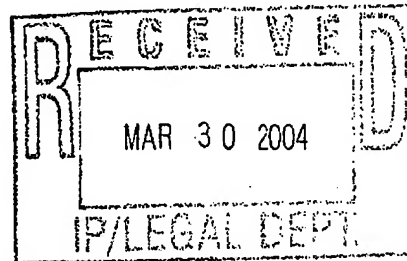
ART UNIT

PAPER NUMBER

1647

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

*MZZ*

*C1 filed
12-16-03*

3/23/04

Notice of Abandonment

Application No.

09/397,846

Examiner

David S Romeo

Applicant(s)

PRESNELL ET AL.

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 16 June 2003.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

David S Romeo
David S Romeo
Primary Examiner
Art Unit: 1647

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Application/Control Number: 11/557,689

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Art Unit: 1647

DETAILED ACTION

Claims 1–12 are pending.

Election/Restrictions

Applicant's election of group I, claims 1–4 in the reply filed on 02/05/2009 is

5 acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 5–12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

10 Election was made **without** traverse in the reply filed on 02/05/2009.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 and 119(e)

15 as follows:

This application is claiming the benefit of prior-filed nonprovisional application No. 09/397,846 under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required. Since the applications are not copending, the benefit claim to the prior-filed nonprovisional application is improper. Applicant is required to delete the
20 reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications.

Art Unit: 1647

Applicants are claiming that this application is a CIP of 10/738,929, filed 12/16/2003, which is a CON of 09/397,846, filed 09/17/1999, which claims benefit of 60/100,706, filed 09/17/1998. However, the Office records indicate that nonprovisional application No. 09/397,846 became abandoned on 09/17/2003. Therefore, nonprovisional application No. 10/738,929, filed 12/16/2003, was not copending with 09/397,846. Therefore, the current application does not receive the benefit of the filing date of the 09/397,846 application.

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/100,706, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Application No. 60/100,706, fails to provide adequate support in the manner provided by the first paragraph of 35 U.S.C. 112 for the limitation "at least 14 contiguous amino acid residues of SEQ ID NO: 24 or SEQ ID NO: 26" (claim 4).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

DOCKET NO.: ZMOG-0099 (98-54C3)
Application No.: 11/557,689
Office Action Dated: May 28, 2009

PATENT

REMARKS

Claims 1-4 are pending. Claims 5-12 have been withdrawn pursuant to a restriction requirement. Claims 1-3 have been amended. Claims 1-3 have been amended to pursue certain embodiments and Applicants expressly reserve the right to prosecute the canceled subject matter in other related applications. Support for the amendments can be found throughout the specification, and the amendments present no new matter.

The priority claim under 35 USC § 119(e), 120, 121, or 365(c) has been denied. The denial is based on the Office's record which does not show co-pendency between the instant application and the prior application from which it claims priority.

Applicants traverse the rejection of priority. The instant application is a CIP of U.S. Application No. 10/738,929, filed December 16, 2003. The '929 application claims priority as a continuation from the 09/397,846 application. The Examiner alleges that the '846 application went abandoned on September 17, 2003, and therefore, was not co-pending with the '929 application as required by statute. Applicants are enclosing and submit as evidence, the Petition and Fee for Extension of Time Under 37 CFR 1.136(a) filed for U.S. Application No. 09/397,846 on December 16, 2003. Based on this evidence, U.S. Application No. 09/397,847 was still pending when U.S. Application No. 10/738,929 was filed on December 16, 2003. Applicants respectfully request that Examiner grant the priority of all the applications in the chain of priority to each of the pending claims.

Claim 4 has been rejected under 35 USC § 102 (a or e) as being anticipated by US Application 2003/0003545.

Applicants traverse the rejection and for the reasons stated above submit the rejection has been obviated by the evidence verifying the co-pendency of US Patent Application No. 09/397,846. Applicants respectfully request the rejection be withdrawn and the claim allowed.

Claims 1-4 have been rejected under 35 USC § (b) as being anticipated by Starnes, J. Immunol. 169(2):642-6, 2002.

Electronic Acknowledgement Receipt

EFS ID:	7550430
Application Number:	09397846
International Application Number:	
Confirmation Number:	9291
Title of Invention:	MAMMALIAN TRANSFORMING GROWTH FACTOR BETA - 9
First Named Inventor/Applicant Name:	SCOTT R. PRESNELL
Correspondence Address:	PAUL G LUNN ESQ ZYMOGENETICS INC 1201 EASTLAKE AVENUE EAST -
	SEATTLE WA 98102 US -
Filer:	Deborah A. Sawislak/Laura Workman
Filer Authorized By:	Deborah A. Sawislak.
Attorney Docket Number:	98-54
Receipt Date:	04-MAY-2010
Filing Date:	17-SEP-1999
Time Stamp:	18:02:13
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no
File Listing:	

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Miscellaneous Incoming Letter	Transmittal.pdf	179759	no	1
			8899fddc7a5ff50a98fe6fda04d67a57772cb5c		
Warnings:					
Information:					
2	Petition for review by the Office of Petitions.	Petition_to_Withdraw_Holding_of_Abandonment.pdf	76537	no	2
			8bd72041ff294c13e7a1fdff60ucc65da1d0433f		
Warnings:					
Information:					
3	Petition for review by the Office of Petitions.	Exhibit_A.pdf	39704	no	1
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Warnings:					
Information:					
4	Petition for review by the Office of Petitions.	Exhibit_B.pdf	52778	no	1
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Warnings:					
Information:					
5	Petition for review by the Office of Petitions.	Exhibit_C.pdf	75907	no	2
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Warnings:					
Information:					
6	Petition for review by the Office of Petitions.	Exhibit_D.pdf	83048	no	2
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Warnings:					
Information:					
7	Petition for review by the Office of Petitions.	Exhibit_E.pdf	56065	no	1
			7cd42a7c71611b780446a6ce16651c934ee567d0		
Warnings:					
Information:					
Total Files Size (in bytes):			563798		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.